

REMARKS

This paper is responsive to an Office Action dated October 4, 2005. Prior to this response, claims 1-18 were pending. After amending claims 1, 3-4, 6, 8, 10-11, 13, and 15-18, and canceling claims 2 and 12, claims 1, 3-11, and 13-18 remain pending.

Section 1 of the Office Action states that claims 1-18 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Shiota et al. ("Shiota"; US Patent 6,185,000). With respect to claims 1 and 10, the Office Action acknowledges that Shiota fails to describe converting the image to a bitmap, but states that programs such as Microsoft Paint and Photoshop are examples of programs that convert images into a bitmap format. Zhou (US 6,898,316) and Hayashi (US 6,469,738) are also mentioned as patents that discuss the use of bitmaps. The Office Action states that it would have been obvious to implement a program to convert an image into a bitmap. With respect to claim 11, the Office Action states that although Shiota fails to explicitly disclose a controller, such a function is inherent in a computer. The Office Action also states that a computer monitor acts as a user interface. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaech* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Shiota describes a personal computer (PC) that accepts a memory card with a digital image, to which additional information has been added, such as a title or date (col. 3, ln. 46-65). A program residing in the PC is able to display the image in the form of a printing instruction screen 9. Using the printing instruction screen 9, a user is able to manipulate the additional information, and add it to the image data 7. The resultant file can be transported via a medium such as a hard disk 4, and loaded into a printer 5. Generally, Shiota describes a system such a Photoshop, which permits a digital image to be modified before it is sent to the printer.

In contrast to Shiota, the invention of amended claims 1, 10, and 11, permits a user to perform all of the above-described functions at the printer. The claimed invention permits a user to skip the in-between step of using a PC with an image processing program and print driver, to make image modifications, prior to sending an image to the printer.

With respect to the first *prima facie* requirement, the combination of Shiota with imaging processing applications such a Photoshop does not suggest that a printer can be used to add time stamp information into an image. Rather, all the references suggest that the time stamp addition process must be performed using a PC, and that a printer cannot be enabled to perform the time stamp addition process.

Considered from the perspective of the second *prima facie* requirement, even if an expert were given the Shiota invention, along with the MS Paint, Photoshop, Zhou, and Hayashi applications as a foundation, there is no reasonable expectation that this expert could derive the claimed invention, since all the prior art references suggest that image modifications must be performed with either a PC or a camera, prior to being sent to the printer. Alternately stated, the references all assume that a print driver application is required to implement the time stamp processing.

With respect to the third *prima facie* requirement, the combined references do not disclose all the elements of the claimed invention. Claims 1, 10, 11 describe image processing being performed by a printer in response to prompts at the printer's front panel. As mentioned earlier, the prior art references all perform the image processing prior to being sent to the printer.

Further, claims 1, 10, and 11 describe a process of embedding time stamp bitmap information into the image bitmap information. None of the prior art references, including the Zhou and Hayashi references describe a printer that is able to embed time stamp bitmap information in an image bitmap. Alternately stated, the claimed invention time stamp bitmap information is embedded in the image bitmap without the use of a specialized printer driver (i.e., Photoshop).

In fact, none of the references create a modified image by embedding additional bitmap information into an image bitmap. The Applicant does not claim to have any special knowledge of the MS Paint and Photoshop applications. Typically however, an image consists of raw image and attributes about the image, as described in the present

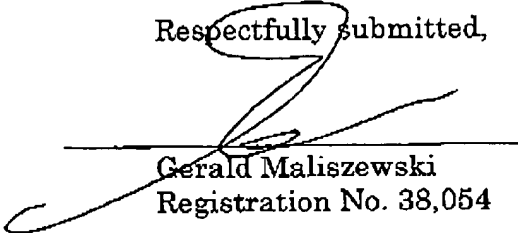
invention specification, as well as Shiota. When a conventional image processing application adds a title to an image, the application sets up the attribute (i.e., title) of the image for printing, without necessarily modifying the image itself. The application used to support the printing of the image then draws the title on top of the image. In a sense, when the printer actually gets the image, it is a modified image with the title superimposed on top of the image. Although the end result may appear similar to an image created using the claimed invention, the Applicant respectfully submits that the superimposition process is not the same process as embedding time stamp bitmap information into the image bitmap information. None of the cited references described this bitmap information embedding limitation.

The Shiota patent, even when combined with Zhou, Hayashi, MS Paint, and Photoshop, does not explicitly describe all the limitations of claims 1, 10, and 11. Neither do the references suggest any modifications that that make the claim limitations obvious. Claims 3-9, dependent from claim 1, claims 13-18, dependent from claim 11, enjoy the same distinctions from the cited prior art, and the Applicant requests that the rejection be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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